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## **REMARKS**

At the time the Office Action was mailed, claims 1-65 were pending in the present application. No claims are presently canceled, added, or amended. Accordingly, claims 1-65 remain currently pending.

In the Office Action, claims 1-65 were rejected. Specifically, claims 1-6 and 34-38 were rejected under 35 U.S.C. § 102(e) as being anticipated by Judd et al. (U.S. Patent No. 6,360,215) (“Judd”). Claims 7-33 and 39-65 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Judd in view of Frank et al. (U.S. Pub. No. 2002/0078035) (“Frank”). In view of the following remarks, the Applicant respectfully requests withdrawal of all rejections and allowance of all pending claims.

### **Rejections under 35. U.S.C. § 102**

The Examiner rejected claims 1-6 and 34-38 under 35 U.S.C. § 102(e) as being anticipated by Judd et al. (U.S. Patent No. 6,360,215). Specifically, regarding independent claims 1 and 34, the Examiner stated:

As to Claim 1, 34, Judd teaches a system which including ‘computer implemented method of indexing a database of documents, a subset of the documents containing nested fields, each nested field having an associated start meta word and end meta work, each meta word having an associated nesting level’ [see Abstract];

‘indexing each document containing nested fields’ [fig 4A]; ‘parsing the document to determine locations within the document of words’ [col 16, line 29-33];

‘meta words in the document and to determine the nesting level associated with each meta word’ [col 9, line 1-14, fig 3], meta words corresponds to meta information such as the title of a documents, abstract and or like as detailed in col 9, line 7-10;

‘generating an index’ [col 7, line 41-50, col 8, line 22-29];

‘word entries, each word entry identifying locations within the document of an identified word’ [col 7, line 51-64, col 8, line 54-59];

‘meta word entries, each meta word entry identifying locations within the document of an identified meta word and indicating the determined nesting level associated with the meta word’ [col 9, line 1-11, line 40-54];

‘generic meta word entries, each generic meta word entry identifying locations within the document of a class of meta words, including meta words at all nesting levels of the meta words found in the document’ [col 10, line 14-27]; ‘generic meta word entry including, for each identified location within the generic meta word entry, information identifying the nesting level associated with the meta word at the identified location’ [col 10, line 38-48, fig 2B].

Office Action, pages 2-3.

Applicant respectfully traverses these rejections. Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under Section 102, a single reference must teach each and every element or step of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Thus, if the claims recite even one element not found in the cited reference, the reference does not anticipate the claimed invention.

The Judd reference cannot anticipate the present claims because Judd does not disclose each and every element of the claims. For example, independent claim 1 of the present application recites, “parsing the document to determine ... meta words ... and to determine the *nesting level* associated with each meta word ... indicating the determined *nesting level* ... and ... identifying the *nesting level* associated with the meta word at the identified location.” Independent claim 34 recites, “configuring the computer to: parse the document to determine ... meta words ... and to determine the *nesting level* associated with

each meta word ... indicating the determined *nesting level* ... and identifying the *nesting level* associated with the meta word at the identified location.”

The Judd reference does not disclose meta words having associated nesting levels as defined by the present application. Furthermore, Judd certainly does not disclose determining, indicating, and identifying such nesting levels. The Judd reference merely discloses tag words that are associated with documents, where a tag word is “any character string that is to be associated with a document for search purposes.” Judd, col. 9, lines 1-2. While tag words may comprise “meta-information,” Judd does not disclose nesting levels associated with meta words as presently recited. *See* Judd, col. 9, lines 1-14. For example, while the Abstract of Judd is relied on to teach “each meta word having an associated nesting level,” the Applicant asserts that it does not actually teach these elements. *See* Office Action, page 2. The entire Abstract from Judd relied on in support of the rejection with respect to these elements is set forth below:

A method and apparatus are provided for retrieving documents from a collection of documents based on information other than the contents of a desired document. The collection of documents, which may be a hypertext system or documents available via the World Wide Web, is indexed. In one embodiment, an indexing process of a search engine receives one or more specifications that identify documents, or document locations, and non-content information such as a tag word or code word. The indexing process searches the index to identify all documents in the index that match one or more of the specifications. If a match is found, the tag word is added to the index, and information about the matching document is stored in the index in association with the tag word. A search query is submitted to the search engine. The search query is automatically modified to add a reference to the tag word, such as a query term that will exclude any index entry for a document associated with the tag word. The search is executed against the index, and a set of search results is generated. Accordingly, the search results automatically exclude all documents associated with the tag word. These techniques may be used, for example, to implement a Web search service that produces more accurate search results or that prevents certain documents, such as pornographic materials, from appearing in search results.

As is clear from this passage, the teachings of Judd have nothing to do with meta data having associated nesting levels. In fact, the Applicant asserts that the Judd reference merely discloses retrieving documents from a collection comprising indexing documents using a tag word and modifying a search query to reference the tag word. *See* Judd, Abstract. Contrary to the assertion in the Office Action, there is no teaching or suggestion in Judd of meta data having associated nesting levels.

For at least the reasons set forth above, the Judd reference fails to teach each and every element of independent claims 1 and 34. Further, Judd fails to teach each and every element of dependent claims 2-6 and 35-38 based on their respective dependencies and for unique matter recited therein. Thus, the Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-6 and 34-38 and provide an indication of allowance.

#### **Rejections under 35 U.S.C. § 103**

The Examiner rejected claims 7-33 and 39-65 under 35 U.S.C. § 103(a) as being unpatentable over Judd et al. (U.S. Pat. No. 6,360,215) in view of Frank et al. (U.S. Pub. No. 2002/0078035). The Applicant respectfully traverses.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a

convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (Bd. Pat. App. & Inter. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

The Judd reference cannot anticipate the present claims because Judd does not disclose each and every element of the claims. For example, independent claims 7 and 39 of the present application recite, “determining the nesting level of the selected meta word.” Independent claims 16 and 48 recite, “determining the nesting levels of the first and second meta words.” Independent claims 29 and 61 recite, “identifying nesting level information for the bounding meta word at the bounding location.”

As discussed above, the Examiner rejected claims 7-33 and 39-65 under 35 U.S.C. § 103(a) as being unpatentable over the Judd reference in view of the Frank reference.

Specifically, the Examiner relied on the Judd reference for its alleged teaching of nesting levels as recited in independent claims 7, 16, 29, 39, 48 and 61. However, as discussed regarding the rejection under 35 U.S.C. § 102, the Judd reference is deficient because it does not disclose nesting levels. Further, the Frank reference does not obviate the deficiencies of the Judd reference.

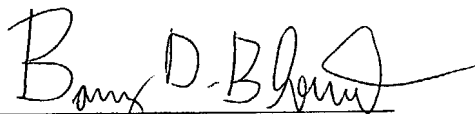
For at least these reasons, the combination of Judd and Frank fails to meet the limitations of independent claims 7, 16, 29, 39, 48 and 61. In view of these deficiencies, the Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 103 of claims 7, 16, 29, 39, 48, 61, and the claims dependent thereon.

### **Conclusion**

In view of the remarks and amendments set forth above, the Applicant respectfully requests allowance of the pending claims 1-65. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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